

REMARKS

Claims 1-6, 8-13, 15-17 and 19-31 are pending in the present application. Claims 1-6, 8-13, 15, 16 and 30 have been allowed. Claims 17 and 19-23 have been rejected under 35 U.S.C. §101, and in the Decision mailed February 5, 2008, the BPAI set forth a new ground of rejection in rejecting claim 31 under 35 U.S.C. §101. Claims 1, 19, 21-23, and 31 have also been rejected under 35 U.S.C. §102(e) over Moeller et al. (USP 6,694,384). Claims 20 and 24-29 have been rejected under 35 U.S.C. §103(a) over Moeller et al. in view of Appellant's Admitted Prior Art.

In response to the new ground of rejection of claim 31 under §101 issued by the Board in the Decision mailed February 5, 2008, Applicant elected to reopen prosecution pursuant to 37 C.F.R. §41.50(b). In the Response dated April 7, 2008, Applicant amended claims 17, 19-24, 27, and 31 to overcome the new grounds of rejection of claim 31 and place claims 17, 19-29, and 31 in condition for allowance. Responsive thereto, the Examiner mailed an Office Communication on May 9, 2008, refusing entry of the amendments on the grounds that "prosecution is closed." *Office Communication*, May 9, 2008, p. 2. Applicant respectfully disagrees and believes that the Examiner has improperly refused entry of the amendments pursuant to 37 C.F.R. §41.50(b) and MPEP §1214.01.

37 CFR §41.50(b) provides that an application will be remanded to the Examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board. *See also MPEP §1214.01*. An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. *See MPEP §1214.01*, citing *Ex parte Burrowes*, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). The amendments submitted in the Response dated April 7, 2008 constituted an "appropriate amendment," as the amendments included an amendment to claim 31 to overcome the new ground of rejection under 35 U.S.C. §101 issued by the Board.

As outlined in the Board's Appeal on pages 10-11, and in 37 CFR §41.50(b), and in MPEP §1214.01, when a new ground of rejection is raised by the Board, there are only two options: (1) reopen prosecution, or (2) request rehearing. Applicant reopened prosecution. Clearly, Applicant's Amendment addressed the new grounds of rejection, and is therefore clearly appropriate. If the Examiner disagrees, the Examiner cannot simply issue a Miscellaneous Action, as the Examiner did in this case, but must treat it as a Request for Rehearing. *See MPEP §1214.01*.

The Examiner has improperly maintained that prosecution is closed. Nevertheless, Applicant hereby again elects to reopen prosecution pursuant to 37 C.F.R. §41.50(b). Applicant has amended claim 31 to overcome the new rejection issued by the Board in the Decision mailed February 5, 2008. Applicant has also newly added claims 32-42 and canceled claims 17-29. Amended claim 31 and new claims 32-42 are appropriate under 37 CFR §41.50(b) and MPEP §1214.01. Specifically, Applicant believes that amended claim 31 and newly presented claims 32-42 are “appropriate amendments,” as claim 31 has been amended to overcome the new rejection thereto under 35 U.S.C. §101 set forth by the Board. Furthermore, none of amended claims 31-42 are directed to subject matter whose rejection was previously affirmed by the Board. That is, Applicant is not attempting to challenge “the basis of [an] affirmed rejection [that] is not open to further prosecution” in opposition to any decision by the Board. The prior art rejection of the subject matter of claims 31-37 under §102(e) over Moeller has not been “already adjudicated” as asserted by the Examiner, as the Board did not affirm the rejection of the subject matter of those claims. *See Decision on Appeal*, February 5, 2008, p. 7 (“we do not address the rejections of [claims 17, 19, 21-23, and 31] under 35 U.S.C. §§102(e) and 103(a)”). Similarly, although the Board did previously affirm the rejection of the subject matter of canceled claim 24 under §103(a) over Moeller et al. in view of Appellant’s Admitted Prior Art, new claim 38 has incorporated additional subject matter into the previously claimed 24 that has not yet been adjudicated on. In light of the above, amended claim 31 and newly added claims 32-42 must be properly entered by the Examiner according to the rules set forth in 37 CFR §41.50(b) and MPEP §1214.01.

Regarding the new claims, the Examiner is directed to MPEP §1214.01(I) which states: “an amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate.” Clearly, as long as Applicant properly amends the claim, or claims, that are newly rejected by the Board, Applicant is entitled to entry of new claims. It is noted that in reopening prosecution, as long as Applicant does not raise issues already decided by the Board, Applicant is entitled to “reopen prosecution” that includes the ability to make amendments and add new claims. *See* MPEP §1214.01.

Applicant further believes that which is called for in claims 31-42 is patentably distinct over the cited references. That is, Applicant believes that claim 31 is patentably distinct over Moeller for reasons previously indicated by the Examiner with respect to allowed claims 1-6, 8-13, and 15-16. Claim 31, and the claims dependent therefrom, are thus in condition for allowance. Additionally, Applicant believes that claim 38 is patentably distinct over Moeller in view of Appellant’s Admitted Prior Art. Claim 38 calls for, in part, a GUI to request activation of an inactive software program resident in memory of a

medical imaging scanner remotely located from a centralized processing center, the GUI including a period-of-use selector thereon. Moeller fails to teach a period-of-use selector, but instead, merely discloses that a user is able to use enabled features “for a desired period of time.” *Moeller*, Col. 5, ln. 13. Moeller discloses that, when the user no longer desires to use the selected features, the user calls the scanner company to disable the previously selected features. *Moeller*, Col. 5, lns. 20-23. As the user is required to call to cancel enabled features, it is clear that the system of Moeller does not include a period-of-use selector that allows a user to select a specified period of enablement at the time when requesting features to be activated. As such, Moeller fails to teach that which is called for in claim 38.

Entry of the above amendments is required under 37 CFR §41.50(b) and MPEP §1214.01, as the above amendments (1) address the new grounds of rejection set forth by the Board in the Decision dated February 5, 2008, rejecting claim 31 under 35 U.S.C. §101, (2) are not directed to subject matter whose rejection was affirmed by the Board and do not challenge the basis of an affirmed rejection that is not open to further prosecution, and (3) are not directed to new subject matter.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-6, 8-13, 15-16, and 30-42. Applicant has cancelled an equal number of claims as the new claims presented and therefore believes no fee is required for entry of the newly presented claims.

Applicant appreciates the Examiner’s consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

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